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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,016	04/08/2004	Chiu-Chien Yuan	24061.93 (TSMC2003-0372)	9310
43717 7590 12/29/2010 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER SHAW, PELING ANDY				
ART UNIT		PAPER NUMBER		
2444				
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12/20/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/821,016

**Applicant(s)**

YUAN ET AL.

**Examiner**

PELING A. SHAW

**Art Unit**

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Amendment received on 10/04/2010 has been entered into record. Claims 1, 3 and 10 are amended. Claims 1-26 are currently pending.
2. Amendment received on 04/01/2010 was entered into record. No claim was amended. Applicant argued that claim 1-18 rejections have not recited authority in its support (see paragraph 1 on page 6 of current amendment). Examiner revised the rejections with a recitation of authorization in current action. The previous Non-Final Rejection mailed on 01/07/2010 was re-issued.
3. Amendment on the claims received on 06/12/2009 was listed claim 20 twice and was not entered into record. The Arguments as per Amendment received on 06/12/2009 was considered as per Advisory Action mailed 06/29/2009.
4. Amendment received on 01/12/2009 was entered into record. Claims 1, 3 10 and 19-26 were amended.

**Priority**

5. This application has no priority claim made. The filing date is 04/08/2004.

**Claim Rejections - 35 USC § 112, second paragraph**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph as following:

- a. Claims 1, 3 and 10 recite the limitation of "by the computer". There is insufficient antecedent basis for this limitation in the claim. Claims 1, 3, 10 and their dependent claims are rejected under 35 U.S.C. 112, second paragraph.

For the purpose of applying art, claims 1 and 10 are read as to have at least one instance of "by a computer" respectively.

**Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 10-14, 16 and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Lu et al. (B2B in TSMC Turnkey Services), hereinafter referred as Lu.

- a. Regarding claim 1, Lu disclosed in a semiconductor manufacturing environment with a plurality of separate entities (background), a computer-implemented method for circulating a file between the entities (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send shipping instruction to subcontractor and shipping alert to customers through a XML format and e-mail) comprising: selecting at least one of a plurality of input files (3rd paragraph on left column of page 41 and 5th paragraph on right column of page 41: entering inventory INSLIP data); selecting an output file format from a plurality of output file formats (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send in XML format); selecting a mode for circulation from a plurality of modes for circulation (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: e-mail); extracting by the computer file information from the selected at least one input file to an output file in the selected output file format (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: process INSLIP, send shipping instruction and shipping

- alert in XML format) ; and circulating by the computer the output file to at least one recipient entity using the selected mode for circulation (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send to subcontractors and/or customers).
- b. Regarding claim 2, Lu disclosed the computer-implemented method of claim 1, wherein the at least one input file comprises a product manufacturing report from a semiconductor foundry (4th paragraph on left column of page 41: cycle time reports and yields reports).
- c. Regarding claim 3, Lu disclosed the computer-implemented method of claim 1, further comprising converting by the computer the at least one input file to a different file format prior to the extracting (2nd paragraph on left column of page 44: aggregate all subcontractor's information in one format).
- d. Regarding claim 4, Lu disclosed the computer-implemented method of claim 1, wherein the mode for circulation comprises e-mail (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send through e-mail).
- e. Regarding claim 5, Lu disclosed the computer-implemented method of claim 1, wherein the mode for circulation comprises facsimile (3rd paragraph on left column of page 44: exchange the hard copy WO and invoice through FAX).
- f. Regarding claim 7, Lu disclosed the computer-implemented method of claim 1, wherein the at least one input file comprises at least two input files (3rd paragraph on left column of page 41 and 3rd paragraph on left column of page 42: integrate lot status (FAB + Circuit Probing + AS + FT)).

- g. Regarding claim 10, Lu disclosed a computer-implemented method for circulating a file associated with the manufacture or sale of semiconductor devices, the method comprising: closing by the computer an application file responsive to a user request (in light of paragraph 23 on pages 5-6 and paragraph 59 on page 13 of applicant's specification; 4th paragraph on left column of page 43: request for reporting system); querying by the computer the user if the application file is to be circulated (3rd paragraph on left column of page 41: report oriented, yield data, ship alarm, produced some kinds of data to ask the subcontractor to provide, electronic purchase order, confirmed shipping dates), wherein the preparing comprises converting the application file to another application file type if necessary (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: process INSLIP, send shipping instruction and shipping alert in XML format); if the application file is to be circulated, checking and determining by the computer the application file type (2nd paragraph on left column of page 43: format/data type check, content context check); preparing by the computer the application file for circulation (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: process INSLIP, send shipping instruction and shipping alert in XML format); and circulating by the computer the output file to at least one recipient (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send to subcontractors and/or customers) using a selected one of a plurality of circulation modes (last paragraph on right column of page 43 through 1st paragraph on left column on page 44: send to subcontractors and/or customers).

- h. Claims 11-14 and 16 are of the same scope of claims 2-5, 7 and 10. These are rejected for the same reasons as for claims 2-5, 7 and 10.
- i. Claims 19-23 are of the same scope of claims 1-5. These are rejected for the same reasons as for claims 1-5.

Lu disclosed all limitations of claims 1-5, 7, 10-14, 16 and 19-23. Claims 1-5, 7, 10-14, 16 and 19-23 are rejected under 35 U.S.C. 102(b).

**Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8-9, 15, 17-18 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu and further in view of Nicholls et al. (US 6363414 B1), hereinafter referred as Nicholls.

- a. Lu has shown claims 1, 10 and 19 substantially as claimed. Lu does not explicitly show wherein the mode for circulation comprises a wireless device. However Lu does show circulating files in FAX or e-mail (see claim 13-14 rejections above).
- b. Nicholls shows (column 1, lines 16-42) that any device capable transmitting electronic data can now send and receive e-mail message (e.g. cellular phone and hand-held computer devices having wireless communication capabilities) in an analogous art for the purpose of converting an email message to a different format and retransmitting to a location other than recipient address information in the email message.
- c. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Lu's functions of B2B in turnkey services with Nicholls' functions of transmitting e-mail in wireless communication.

- d. The modification would have been obvious because one of ordinary skill in the art would have been motivated to apply e-mail over wireless electronic data transporting capability per Nicholls as applied to the general art of e-mail communication as per Lu's (last paragraph on right column of page 43 through 1<sup>st</sup> paragraph on left column on page 44) and Nicholls (3<sup>rd</sup> paragraph in column 1)'s teaching.
- e. Regarding claim 8, Nicholls shows wherein the mode for circulation comprises sending an e-mail to at least two different entities, the at least two different entities having different e-mail systems (Fig. 2a and column 2, line 49 through column 3, line 321: internet based e-mail, delivery e-mail via facsimile, pager or telephony).
- f. Regarding claim 9, Nicholls shows wherein the mode for circulation comprises sending an e-mail to at least one entity, and sending a facsimile to at least one other entity, the at least one other entity being at a different location than the at least one entity (column 5, line 52 through column 6, line 16: received e-mail may be faxed to subscriber's home facsimile machine).
- g. Claims 15, 17-18 and 24-26 of the same scope as claims 1, 6 and 8-10. These are rejected for the same reasons as for claims 1, 6 and 8-10.

Together Lu and Nicholls disclosed all limitations of claims 6, 8-9, 15, 17-18 and 24-26.

Claims 6, 8-9, 15, 17-18 and 24-26 are rejected under 35 U.S.C. 103(a).

### **Response to Arguments**

9. Applicant's arguments filed on 10/04/2010 have been fully considered, but they are not persuasive.
- a. Applicant has argued that Lu does not teach or suggest the limitations of "selecting at least one of a plurality of input files" (see 3<sup>rd</sup> and 4<sup>th</sup> paragraphs on page 7 of Amendment received on 10/04/2010) and "selecting an output file format from a plurality of output file formats" (see 2<sup>nd</sup> paragraph on page 8 of Amendment received on 10/04/2010) and "selecting a mode for circulation from a plurality of modes for circulation" (see 3<sup>rd</sup> paragraph on page 8 of Amendment received on 10/04/2010).
  - b. As for the argument on the limitation of "selecting at least one of a plurality of input files", examiner has reviewed applicant's original published specification and claim language. As applicant's original claim 2 states that an input file could comprise a product manufacturing report. The quoted 3<sup>rd</sup> paragraph on left column of page 41 and 5<sup>th</sup> paragraph on right column of page 41 from LU clearly teaches a B2B setup for connection between TSMC and its subcontractor for data input inputs from various sources in different formats and generating reports. Thus the limitation of "selecting" is suggested as an implementation of intended application similar to what is described in the quoted section of LU. Examiner has reviewed and found LU has further shown in the bottom of page 42 that the file exchange based upon FTP for B2B connection and as further described in the last paragraph on the right column of page 42.

- c. As for the argument on the limitation of “selecting an output file format from a plurality of output file formats”, examiner has reviewed applicant’s original published specification and claim language. As paragraphs 17 and 58 of applicant’s original specification, the output file format is of file structure for different needs and building blocks for business reports. The quoted last paragraph on right column of page 43 through 1st paragraph on left column on page 44 from LU has described sending shipping instruction through a XML format to the subcontractor and sending a shipping alert to the customer through e-mail. Those do suggest using different formats for outputting.
- d. As for the argument on the limitation of “selecting a mode for circulation from a plurality of modes for circulation”, examiner has reviewed applicant’s original published specification and claim language. As applicant’s original claims 4 and 5 state that a mode could comprising e-mail or facsimile. The quoted last paragraph on right column of page 43 through 1st paragraph on left column on page 44 from LU has described sending shipping alert to the customer through e-mail and auto issue shipping instructions and alerts in FAX. Those do suggest using different modes for circulation as per applicant’s claim language.
- e. Claim rejections are updated to reflect the current amended claim changes as above.

### **Conclusion**

1. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peling A Shaw/  
Primary Examiner, Art Unit 2444